

REMARKS

Status of Application

Claims 1-3, 5-10, 14-23 and 25-29 are pending in the Application. Claims 1-3 and 5 are amended. Claim 4 is canceled. New claims 25-29 are amply supported by the present disclosure and add no impermissible new matter.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4 and 5 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,391,439 to Nakano ("Nakano"). Applicant traverses this rejection for at least the following reasons.

Claim 4 is canceled, thereby rendering its rejection moot.

Claim 1 is amended to require that "the indication information is written by irradiating light in a form of an image onto the indication layer." The Examiner contends that these features of amended claim 1 are taught by Nakano at col. 4, lines 20-35.

The Examiner characterizes this portion of Nakano as allegedly teaching that "the image is visually perceived based on incident light." However, the above-quoted portion of amended claim 1 requires that "information is written by irradiating light." Thus, although it may be conceded that the label of Nakano is visually perceived based on light reflected from the surface of the label base layer 1, Nakano lacks any teaching of a method of writing indication information by irradiating the surface of the label base layer 1 with light. Any purported writability discussed in the cited portion of Nakano relates to magnetization, not light irradiation.

Thus, Nakano fails to teach each and every required element of amended claim 1 and, therefore, fails to anticipate claim 1. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of amended independent claim 1 and its dependent claims 2 and 5.

Claim Rejections Under 35 U.S.C. § 103

Anderson '205 in view of Araki

Claims 3, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,778,205 to Anderson et al. ("Anderson '205") in view of U.S. Patent Application Publication No. 2003/0103762 to Araki et al. ("Araki"). Applicant traverses this rejection for at least the following reasons.

Claim 3 is amended to recite "wherein said recording medium is substantially planar and circular in shape." The Examiner straightforwardly concedes that the alleged motivation to combine previously advanced by the Examiner is baseless: "The Examiner concedes this fact." (Office Action at 2.) However, the Examiner now contends that a motivation to combine the references is not required, arguing instead that "substituting an indication layer of a cholesteric layer and a transparent electrode on a light absorbing layer in place of the writable label of Anderson . . . is well within the scope of knowledge that is known to one of ordinary skill in the art because the substitution results in a predictable result." (Office Action at 3.)

Although Anderson '205 does disclose an optical disk, further untaught features would be required, beyond the indication layer of Araki and the optical disk of Anderson '205, in order to reach the recording medium of claim 3.

Fig. 1 of Araki shows a device in which a plurality of rectangular image record media 14 having connectors 12 and external connection electrodes 13 are slotted into a medium connection section 11. Neither Araki nor Anderson '205 teach or suggest how to modify elements 12 and 13 of Fig. 1 of Araki, or more generally, what further features would be required in order to integrate the indication layer of Araki with an optical disk such as that of Anderson '205. Clearly, such a modification is not merely a simple substitution, as the circular shape and rotating motion of an optical disk would prevent it from being slotted into a device such as the medium connection section 11 of Araki.

Thus, Anderson '205 and Araki, alone or in combination, fail to teach or suggest each and every required element of claim 3. These references, therefore, fail to render claim 3 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 3 and its dependent claims 22 and 23.

Anderson '205 in view of Anderson '586

Claims 6, 7, 9, 10, 14-19 and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of U.S. Patent No. 7,145,586 to Anderson et al. ("Anderson '586"). Applicant traverses this rejection for at least the following reasons.

Claim 6 requires "a detecting section detecting a difference between storage data which is stored at the storage layer of the recording medium, and new data which is to be subsequently stored; and . . . wherein the storing section stores, . . . at the indication layer, the indication information which corresponds to the difference."

The Examiner argues that this feature is disclosed in steps 608 and 610 of Fig. 6, and col. 7, lines 49-60 of Anderson '586. The Examiner states that "when the list of files or the space

used or remaining on the disc changes, the information related to the data side of the optical disc is reread and the change is determined.” (emphasis added.) However, the cited portions of Anderson ‘586 fail to teach a step in which the change is determined.

Steps 608 and 610 of Fig. 6 are labeled “determine information based on data side of optical disc” and “determine existing marking on data side or label side of optical disc.” Neither of these descriptive labels describe actually detecting the difference between new and old data. Furthermore, step 612 is labeled “update marking on data side or label side of optical disc based on data side as has been reread.” (emphasis added.) Thus, the markings on the disk are actually updated based on a re-reading of the data side, not based on “indication information which corresponds to the difference,” as claimed.

Moreover, although col. 7, lines 49-60 of Anderson ‘586 do appear to show that “information related to the data side of the optical disc is reread” as the Examiner contends, but subsequently, do not describe determining the change. Col. 7, line 61 states that “[t]he marking is then updated based on the information related to the data side of the optical disc as has been again determined (612).”

Col. 7, line 61 – col. 8, line 3 of Anderson ‘586 describe ways of updating the marking, none of which require a previous determination of difference information. This portion states that the marking “can be added to without erasing the marking as previously written,” “may be completely erased and written anew,” or “may also be overstruck or appended to update it.” These three methods describe (1) simply writing the new marking after the previous marking, (2) completely erasing and writing a new marking, and (3) striking through the existing marking and writing the new marking. Since no previous portion of Anderson ‘586 discloses determining a

difference between the previously stored data and the new data, this portion of Anderson '586 must be understood as a modification of the marking without reference to or reliance on such difference information.

Thus, Anderson '205 and Anderson '586, alone or in combination, fail to teach or suggest each and every required element of claim 6. These references, therefore, fail to render claim 6 unpatentable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 6 and its dependent claims 7, 9, 10, 14, and 15.

Independent claim 16 recites features similar to those of claim 6. Claim 16 is, therefore, also patentable at least for reasons analogous to those presented above with respect to claim 6. Accordingly, Applicant respectfully requests that the Examiner also withdraw the rejection of independent claim 16 and its dependent claims 17-19 and 21.

Anderson '205 in view of Anderson '586 and Nakano

Claims 8 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Anderson '205 in view of Anderson '586, and further in view of Nakano. Applicant traverses this rejection for at least the following reasons.

Claims 8 and 20 depend from independent claims 6 and 16, respectively. The deficiencies of Anderson '205 and Anderson '586 with respect to these claims are demonstrated above. Nakano, moreover, fails to remedy these deficiencies. Claims 8 and 20 are, therefore, also patentable at least by virtue of their dependence from claims 6 and 16. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claims 8 and 20.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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